

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed October 24, 2003. At the time of the Office Action, Claims 1-77 were pending in the Application. Applicant cancels Claims 73-75 without prejudice or disclaimer in order to advance prosecution in this case. The cancellation of these claims is not the result of any prior art reference, nor is it the result of any deficiency in the corresponding specification. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Consideration of Information Disclosure Statement

Applicant submitted an Information Disclosure Statement (IDS) on October 2, 2002 that the Examiner has yet to identify as having been considered. Applicant respectfully requests the Examiner to review this IDS and to formally indicate that these materials have been reviewed in the context of the pending prosecution. Applicant suggests the Examiner use a PTO Form 1449 to provide written notification to this effect.

Section 112 Rejections

The Examiner rejects Claims 73-75 under U.S.C. §112, first paragraph. Applicant has cancelled these claims in order to advance prosecution in this case and, thereby, to overcome this rejection. Applicant again stresses that these claims have only been cancelled in order to move forward in the prosecution of the other pending claims. The cancellation of these claims should not be construed as any sign of any potential inadequacies with the specification, nor should it be construed as addressing any potential obstacle provided by the references of record. Expediency in the prosecution of this case is the only factor that was considered in canceling these claims.

Section 103 Rejections

The Examiner rejects Claims 1-8, 12, 14-15, 17-30, 34, 42-49, and 50-77 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,587,457 issued to Mikkonen (hereinafter "*Mikkonen*") in view of U.S. Patent No. 6,256,300 issued to Ahmed et al. (hereinafter "*Ahmed*"). The Examiner rejects Claims 9-11 under 35 U.S.C. §103(a) as being unpatentable over *Mikkonen* in view of *Ahmed* and "Convergence Between Public Switching and the Internet" to Schoen, et al. (hereinafter "*Schoen*"). The Examiner rejects Claims 13

and 16 under 35 U.S.C. §103(a) as being unpatentable over *Mikkonen* in view of *Ahmed* and “Mobile IP and Security Issue: An Overview” authored by Perkins (hereinafter “*Perkins*”). Applicant respectfully traverses these rejections for the following reasons.

Applicant notes that the Examiner has failed to satisfy each of the elements of non-obviousness, which are required to support a proper §103 analysis. According to M.P.E.P. §2143, to establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to combine the references. Second, there must be a reasonable expectation of success. Third, the prior art combination of references must teach or suggest all the claim limitations.¹ As an initial matter, the Examiner has failed to meet his burden with respect to the third criteria of non-obviousness.

Independent Claim 1 recites, in part, a traffic controller operable to convert wireline packets received for the call from the wireline network to wireless packets, to route the wireless packets to the mobile device through the first interface, to convert wireless packets received for the call from the mobile device to wireline packets, to route the wireline packets to the wireline network through the second interface, and to communicate with other wireless routers. These teachings are simply not found in *Mikkonen*. In contrast to the teachings of Independent Claim 1, *Mikkonen* discloses a method for connecting data flows. The invention relates to a method of supporting the quality of service (QoS) in packet data transmissions between a wireless terminal (MT), having data communication with a radio access network. (See Abstract of *Mikkonen*.) For the teaching of a traffic controller that is operable to communicate with other wireless routers, the Examiner improperly refers to the potential for a handoff in the network, presumptively within the context of a theoretical implementation of *Mikkonen*.

Such tenuous propositions cannot be sustained as a basis for a proper §103 analysis. Evaluating the passage referred to by the Examiner reveals that the teachings of *Mikkonen* could not possibly inhibit the patentability of Independent Claim 1. The term “handoff” is not mentioned anywhere in *Mikkonen*. The Examiner has ostensibly pulled this term from thin air and then used it in his rejection. Applicant can only speculate that the Examiner may be attempting to use the passage in *Mikkonen* that refers to the capabilities of a generic access network. *Mikkonen* provides: “The radio access network comprises the operations for accomplishing data transmission between the wireless terminal MT and the core network 3 as

¹ See generally M.P.E.P. §2143.

well as for controlling wireless resources, for setting up and down wireless data flows or radio flows, for moving the connection from one control station to another (handover), and possibly also for compressing packets.” (See *Mikkonen*, Column 5, lines 48-54.) However, providing a generic access network that is capable of assigning a call (via a handover) is not akin to a traffic controller that is operable to communicate with other wireless routers. Indeed, such an assignment of calls, as specified by *Mikkonen*, implicates one control station to another: not communications between other wireless routers and a traffic controller. For at least this reason, each of the limitations of Independent Claim 1 is not shown, taught, or suggested by *Mikkonen*. This reason alone mandates Independent Claim 1 being patentable over *Mikkonen*. Additionally, claims 2-30 depend from Independent Claim 1 and are, therefore, also allowable over *Mikkonen* for similar reasons.

Turning to Independent Claims 50 and 60, the Examiner repeatedly proffers immaterial teachings of *Mikkonen* that relate to the notion of a handoff. Once again, nowhere in *Mikkonen* is there any disclosure of a handoff. *Mikkonen* only discloses that a generic access network may be capable of assigning a call (via a handover). Moreover, the Examiner has failed to offer any disclosure in *Mikkonen* that refers to a wireless router. The Examiner speculates that such an element “is known in the art” but has not provided a single reference to support his contention. At this point, the Examiner has used several notions (including skill in the art, what is known in the art, inferences from the Examiner, and irrelevant portions of several references) to continue to cantilever such weak propositions on top of each other to produce one large faulty §103 analysis. Noticeable in *Mikkonen* is its failure to disclose a wireless router that includes a resource manager coupled to the selection and distribution unit, the resource manager operable to communicate the selected signal to a wireline network, as recited in Independent Claim 50. For at least this reason, Independent Claim 50 is allowable over *Mikkonen*. Additionally, *Mikkonen* fails to offer an ability to receive a communication from a mobile device identifying an active set of wireless routers for a call, the active set of wireless routers including a primary wireless router and one or more secondary wireless routers for soft handoff of the call, as recited in Independent Claim 60. For at least this reason, Independent Claim 60 is also allowable over *Mikkonen*. In addition, claims 51-59 and 61-63 depend from Independent Claims 50 and 60 respectively and are, therefore, also allowable for similar reasons.

Mikkonen also includes a number of other deficiencies that, for example, preclude it from being relevant to Independent Claims 64 and 76. For example, *Mikkonen* fails to offer

any subject matter patentably relevant to routing the radio frame instances from secondary wireless routers in the active set to a primary wireless router in the active set and selecting at the primary wireless router one of the radio frame instances for transmission to a destination device, as recited in Independent Claim 64. Moreover, *Mikkonen* fails to offer a network anchor wireless router that receives traffic from the destination device and forwards the traffic to the primary wireless router through a virtual path for delivery to the mobile device, as recited in Independent Claim 76. For at least these reasons, Independent Claims 64 and 76 are allowable over *Mikkonen* and notice to this effect is respectfully requested. In addition, claims 65-72 and 77 depend from Independent Claims 64 and 76 respectively and are also allowable for similar reasons.

The Examiner rejects Claims 31-33, and 35-41 under 35 U.S.C. §103(a) as being unpatentable over *Mikkonen* standing alone. Applicant has already expounded on the insignificant teachings of *Mikkonen* but, nevertheless, respectfully traverses this rejection for the following reasons. In regard to Independent Claim 31, *Mikkonen* fails to teach, suggest or even remotely disclose a first virtual path configured between the first and second routers for transmission of wireline protocol traffic. The passages of *Mikkonen* cited to teach this element merely refer to the mobile IP router's control of the access points to transmit radio flow to the wireless terminal. (See *Mikkonen*, Column 5, lines 55-67.) Indeed, *Mikkonen*, in contrast, teaches that the mobile domain (MD) routers 7, 7' control mobility of the wireless terminals MT between domains 6, 6' via the mobile IP routers 5, 5', 5". Poignant to the teachings of *Mikkonen* is that the MD routers 7, 7' control the mobile IP routers 5, 5', 5" do not require a virtual path between a first and a second router. (See *Mikkonen*, Column 6, lines 6-24.) For at least this reason, Independent Claim 31 is allowable over *Mikkonen*. Moreover, Independent Claim 31 also recites a second virtual path configured between the first and second routers for transmission of a wireless protocol traffic. The Examiner has yet to provide the specific portion of *Mikkonen* to suggest, teach, or disclose this element. Its absence from the Office Action is not coincidental; *Mikkonen* fails to offer such a teaching. For this additional reason, Independent Claim 31 is patentable over *Mikkonen*. In addition, dependent claims 32-38 are also allowable for similar reasons. Notice to this effect is respectfully requested in the form of a full allowance of these pending claims.

Turing to Independent Claim 39, *Mikkonen* fails to teach, suggest, or disclose a virtual path label for routing the radio frame to a router for call processing. Instead, *Mikkonen* discloses a radio flow that comprises a radio flow label and definitions for the quality of

service. In a corresponding manner, the mobile IP router 5 has (upon connection forming) selected an IP flow label IPTAG for each IP flow 406. This flow label IPTAG is advantageously an isometric block in the header of the packet...This packet 407 is received at the access point 4 and the IP flow label IPTAG is examined in order to detect the respective flow label RFID. (See *Mikkonen*, Column 9, lines 30-43.) Thus, *Mikkonen* is concerned with a label for a flow and not for a virtual path for routing the radio frame to a router for call processing, as recited in Independent Claim 39. For at least this reason, Independent Claim 39 is allowable over *Mikkonen*, as are its corresponding dependent claims 40-43. Notice to this effect is respectfully requested in the form of a full allowance of these pending claims.

With respect to the first criterion of non-obviousness, the Examiner has not shown a suggestion or a motivation in the references or in the knowledge generally available to one of ordinary skill in the art to combine the cited references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of making the combination.² Thus, the fact that the teachings of one reference (*Mikkonen*) would improve the teachings of any other reference (*Ahmed*, *Schoen*, or *Perkins*), as posited by the Examiner, does not provide the required suggestion to make such a combination. Nothing in *Mikkonen* or in any other cited reference suggests or motivates the proposed combinations. Nor has the Examiner provided any evidence that suggests any of the proposed modifications.³ The Examiner merely speculates that "it would have been obvious" to make the proposed combinations. The Examiner is merely interjecting a subjective conclusory statement in an improper hindsight attempt at rejecting the claims without citing any language from any of the cited references to support the rejection. The Examiner presents no objective evidence from the prior art that suggests or motivates the

² See M.P.E.P. §2143.01.

³ The Examiner is relying on "common knowledge" or "well known" art in support of his rationale for combining the references, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. §2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine, Applicant respectfully requests that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. §2144.03.

combination as is required by Federal Circuit case law.⁴ The M.P.E.P. also confirms that this approach is improper and, thus, it should not be used here.⁵

Furthermore, the Examiner is precluded from modifying the combined teachings of *Mikkonen*, *Ahmed*, *Schoen*, and *Perkins* in an effort to teach the limitations of the pending claims because there is no indication in any of the references as to the desirability of making such modifications. The cited references must disclose the desirability of making the proposed modification.⁶ The fact that the modification is possible or even advantageous is not enough.⁷ A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.⁸

With respect to the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. The combinations of *Mikkonen* and any of the references of record would not be capable of performing the operation required by the claimed invention. For example, there is no showing by the Examiner that the teachings of *Mikkonen* could provide a wireless router capable of offering any of the functions identified above; nor is there any disclosure relating to the other elements identified in the pending claims in the analysis provided supra. The proposed combination (presumptively) attempts to combine divergent subject matter that has not been shown to be capable of operating according to any degree of predictability. The Examiner, without resorting to improper hindsight to look through the claimed invention, has not addressed the chance that the proposed *Mikkonen-Ahmed*, *Schoen*, or *Perkins* combinations would have any success whatsoever: let alone a reasonable expectation of success as is required. Therefore, Applicant respectfully submits that the Examiner has failed to establish the second criteria for a prima facie case of obviousness.

⁴ In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Conclusory statements by the Examiner regarding the teaching of multiple references, standing alone, are not "evidence." *Id.*

⁵ See M.P.E.P. §2145. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to lack of suggestion in the prior art of the desirability of combining references."); see also *In re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].")

⁶ *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

⁷ See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

⁸ *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (See also M.P.E.P. §2141.02).

With respect to the third criterion of non-obviousness, the Examiner has not shown how the proposed combination teaches each and every limitation of the claimed invention. This has been evaluated thoroughly in the tendered analysis provided by the Applicant. With no other supporting references that are combinable with *Mikkonen*, all of the claim limitations have not been taught or suggested by the Examiner's currently proposed combination. Therefore, Applicant respectfully submits that claims 1-73 and 76-77 are patentably distinct from the proposed combinations. All of the pending claims have been shown to be allowable, as they are patentable over all of the references of record. Notice to this effect is respectfully requested in the form of a full allowance of claims 1-73 and 76-77.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee to be due. However, the Commissioner is hereby authorized to charge additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,
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